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SEP 25 2006

PATENT APPLICATION

ATTORNEY DOCKET NO. 10012626-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Sesek et al.

Confirmation No.: 3065

Application No.: 10/006,693

Examiner: S. McAllister

Filing Date: 12/10/2001

Group Art Unit: 3627

Title: Cost and Usage Based Configurable Alerts

Second
Transmission

Mail Stop
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- | | |
|-----------------------------------|--|
| () Response/Amendment | () Petition to extend time to respond |
| () New fee as calculated below | () Supplemental Declaration |
| () No additional fee | |
| (X) Other: Corrected Appeal Brief | (fee \$ _____) |

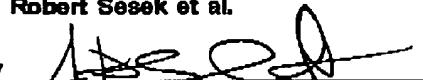
CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1590.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Robert Sesek et al.

By



James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 9/25/06

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OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

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Robert Seseck et al.

By

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 9/25/06

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SEP 25 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 10/006,693
Filing Date.....December 10, 2001
Inventor..... Robert Sesek et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 3627
Examiner..... Steven McAllister
Attorney's Docket No. PDNO. 10012626-1
Confirmation No. 3065
Title:Cost and Usage Based Configurable Alerts

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
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Appellant appeals from the Office Action mailed January 13, 2006 (hereinafter "Office Action") which rejects claims 62-73 and 75-88 over the prior art. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

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Brief of Appellant

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I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC") as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 012700, Frame 0107, and the full assignment to Hewlett-Packard Development Company, L.P. recorded at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 62-88 are pending and stand rejected. Appellants appeal the rejection of claims 62-88.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the Office Action mailed January 13, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to independent claim 62, exemplary controllers are depicted with respect to references 2, 22 of Fig. 1 and described at page 8, lines 18+ of the specification according to one possible embodiment. Usage information is

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described at page 8, lines 17+ according to one embodiment. Printer 8 of Fig. 1 forms hard images on media as described at page 7, lines 26+. A usage profile database 32 of Fig. 1 is described at page 10, lines 21+ of the specification. At page 11, lines 28+ of the specification, exemplary monitoring and comparison of usage information with usage profile data by alert controller 22 and generation of an alert is described according to one embodiment.

Referring to claim 67, the limitations are described according to one embodiment in the implementation of page 14, lines 21+ of the specification.

Referring to claim 69, exemplary disablement according to one embodiment is described at page 14, lines 13+ of the specification.

Referring to claim 70, exemplary disablement according to one embodiment is described at page 14, lines 13+ of the specification.

Referring to claim 72, exemplary aspects regarding the budget plan are discussed according to one embodiment at Fig. 3 of the application and the associated specification teachings of the application at page 13, lines 1+..

Referring to claim 73, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 75, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 76, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 78, exemplary disablement according to one embodiment is described at page 14, lines 13+ of the specification.

Referring to claim 79, usage information is described at page 8, lines 17+ according to one embodiment. A usage profile database 32 of Fig. 1 is described at page 10, lines 21+ of the specification. At page 11, lines 28+ of the specification, exemplary monitoring and comparison of usage information with usage profile data by alert controller 22 and generation of an alert is described according to one embodiment.

Referring to claim 83, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 85, exemplary disablement according to one embodiment is described at page 14, lines 13+ of the specification.

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Referring to claim 86, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 87, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

Referring to claim 88, exemplary identification and adjustment is described according to one possible embodiment at page 14, lines 21+ of the specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 112, first paragraph, rejection of claims 62-88.
- B. The 103 rejection of claims 62, 66-71, 73 and 75-88 over the combination of Paton and Thieret.
- C. The 103 rejection of claims 62-65, 68 and 72 over the combination of Paton and LoBiondo.
- D. The 103 rejection of claim 67 over Thieret and Paton.
- E. The 103 rejection of claims 69-70 over Thieret and Paton.
- F. The 103 rejection of claim 72 over LoBiondo and Paton.
- G. The 103 rejection of claims 73, 75-76, 83 and 86-88 over Thieret, Paton and Hopper.
- H. The 103 rejection of claims 73, 75-76, 83 and 86-88 Thieret, Paton and Hopper.
- I. The 103 rejection of claims 78 and 85 over Thieret and Paton.

VII. ARGUMENT

- A. Claims 62-88 comply with the written description requirement.

Regarding the rejection based on 112, first paragraph, the Examiner is respectfully reminded that the MPEP states the test for sufficiency of support in a application is whether the disclosure relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. MPEP §2163.02 (8th ed., rev. 3) *citing Ralston Purina Co. v Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Notably, the subject matter of the claim need not be described literally (i.e., using the same terms or in

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haec verba) in order for the disclosure to satisfy the description requirement. MPEP §2163.02 (8th ed., rev. 3).

MPEP §2163 I. (8th ed., rev. 3) states it is now well accepted that a satisfactory description may be in the claims or any other portion of the originally-filed specification and an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention (citations omitted).

The Office at page 2 of the Action alleges that limitations of the claims including accessing and comparing usage information as opposed to usage rate information does not appear to be described in the original specification to reasonably convey that Appellants had possession of the claimed invention at the time the application was filed. Appellants respectfully disagree for the following compelling reasons.

Initially, Appellants have not made any representations that the present disclosure is limited to rate analysis and the Office has not pointed to any evidence of record that the disclosure is to be so limited. To the contrary, the original specification is clear that the application is not limited to rate analysis. For example, at page 10, lines 4+ of the specification, it is disclosed that alert controller 22 is capable of reading consumable sensor signals and to make *both absolute sensor readings as well as trend sensor readings*. Alert controller can read a paper level sensor by merely reading the instantaneous level to determine the paper remaining or can make multiple readings over time to determine the rate of consumption of paper. *Rate may be calculated with respect to time* or with respect to item count. Page 10, lines 21+ of the originally filed specification state that Fig. 1 employs a usage profile database 32 (without mention as to rate) and that alert controller 22 gathers absolute and trend data and compares this data with the usage profile database. It is stated that the *usage profiles* without mention of rate can be many and varied. At page 11, lines 5+ of the specification it is stated that database 32 is configured to monitor the consumption for a job and generate an alert when a *predetermined cost or volume has been reached* with no mention of rate. At page 12, lines 3+ of the specification, it is stated that the usage profile database can include absolute values, *rates*, times, dates and other factors. It is

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clear that compiled, stored and analyzed data is not limited to rate data. As set forth at page 13, lines 13+ of the specification, sensory inputs to alert controller 22 are used to calculate various consumption, wear and cost data or parameters that are compared with usage profile data. Per page 13, lines 19+ of the specification it is stated that the deviation of a parameter from usage profile data generates an alert condition (without mention as to rate) and further states that a parameter is a processed output of alert controller 22 that may be a simple level indication or a more complex determination such as a long-term trend calculation. Appellants respectfully submit that at least the above-mentioned teachings show that Appellants possessed the claimed limitations of accessing usage information and comparing usage information to a profile and which are not limited to rate information.

Furthermore, the claims define accessing and comparing information with respect to a period of time which, in at least one implementation, is supported by the rate teachings of the original filed specification. More specifically, Appellants note that the independent claims recite accessing usage information indicative of usage of an expendable which is used *over a period of time*, accessing usage profile data indicative of expected usage of the expendable *over the period of time*, and comparing the usage information with the usage profile data. Accordingly, in one possible interpretation, the independent claims may be considered to define accessing and comparing usage information and usage profile information which include rate information both with respect to time as claimed.

Appellants respectfully submit the claims are adequately described by the originally filed application in view of the numerous specification teachings at least as identified above and in addition in view of the following. MPEP § 2163.07(a) (8th ed., rev. 3) states that by disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973).

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Applicants note MPEP 2163 II. A. (8th ed., rev. 3), states *the Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.* Further, it is stated that if Appellants points out where a claim is supported (as Appellants did at page 6 of the Response filed by Appellants on October 25, 2005), the Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined in the claims.

Further, MPEP 52163.III.A (8th ed., rev. 3) provides in rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

The Office Action merely states that the claim limitations do not appear to be described in the original specification. The Office fails to address the specification or explain how a person skilled in the art would not have recognized that the Appellants were in possession of the limitations of the claims in view of at least the explicit teachings of the original disclosure identified above referring to accessing usage information without reference to rate and comparison of usage information with respect to usage profile data without reference to rate as disclosed in the original specification. Furthermore, the pending claims may be considered to recite accessing and comparing rate information in at least one interpretation due to the explicit language of usage information indicative of usage of an expendable which is used *over a period of time* and usage profile information indicative of expected usage of the expendable *over the period of time*. Appellants submit that the 112 rejection of the claims fails to meet the clear mandate of the MPEP and the Office has failed to establish a *prima facie* 112 rejection for at least the above-mentioned compelling reasons. Appellants respectfully request reversal of the 112 rejection of the claims for the above-recited compelling reasons.

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B. There is insufficient motivation to combine the teachings of Paton with the teachings of Thieret and the 103 rejection of claims 62, 66-71, 73, and 75-88 is improper for at least this reason.

Referring to the 103 rejection of the claims over Thieret and Paton, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3). Applicants respectfully submit the Office has failed to establish *prima facie* 103 rejections of the claims for at least the following compelling reasons.

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness*. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner *to provide some suggestion of the desirability of doing what the inventor has done*. MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale to combine the references provided by the Office is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be *thorough and searching*. It must be based *on objective evidence of record*. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some *objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art* would lead that individual to combine the relevant teachings of the references. The *Lee* Court additionally stated that the factual question of motivation is material to

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patentability and *can not be resolved on subjective belief and unknown authority.* The Court also stated that *deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed.* The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon *objective evidence* and *making specific factual findings* with respect to the motivation to combine references.

Referring to the rejection of claims 62 and 79 on page 3 of the Action, the Office states that the motivation to combine the reference teachings of Paton with Thieret is "to provide a warning when maintenance may have to be performed sooner than expected." Applicants respectfully submit the motivation is presented by the Office is insufficient in view of Federal Circuit authority and the Office has not established a *prima facie* 103 rejection of the claims for at least this reason.

Initially, the background of Thieret indicates the reference is concerned with overcoming difficulties with prior art systems and requirements for large data transmission and bandwidth capacities at col. 1, lines 48+. Applicants respectfully submit there is no evidence of record that one of skill in the art aware of the teachings of Thieret concerned with large data transmission and bandwidth capacities would be motivated to look to the cash dispenser prior art of Paton for meaningful teachings with respect to data transmission and bandwidth capacities. In addition, there is no evidence of record that one concerned with systems and methods of forming hard images as in Thieret would look to cash dispenser prior art of Paton for meaningful teachings. Paton is void of any teachings regarding hard imaging or expendables thereof.

Furthermore, Applicants respectfully submit that Thieret already provides teachings directed towards alerts (col. 7, lines 60+). In particular, it is stated that the server can be programmed to provide alert signals when the conditions of the machine as detected by the server require *immediate attention*. Furthermore, at col. 2, lines 15+ of Thieret, it is disclosed that the machine server is capable of machine trend analysis and diagnostics and an analysis and prediction component to analyze data to track machine trends and *predict machine subsystem and element faults*. Also, Thieret already provides a monitor component 202 which provides

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suitable data regarding usage of disposable components per col. 9, lines 49+. Furthermore, at col. 7, lines 64+ of Thieret it is stated that predictions of failures may be detected and actions may be taken such as *predicted need for service to actually place an order for a part for just in time delivery prior to actual part failure.*

There is no evidence of record that improvements to Thieret over the already disclosed teachings of Thieret would be obtained by the combination of the cash dispenser teachings of Paton to motivate one of skill in the art to combine the reference teachings in the first instance. There is no evidence of record to support the cursory allegation of the Office that the combination of reference teachings would provide an improvement with respect to warning when maintenance may have to be performed sooner than expected compared with the prediction component of Thieret predicting need for service or a part for *just in time delivery prior to the part failure* as already disclosed in the Thieret teachings.

The motivation provided by the Office is redundant to the teachings of Thieret and there is no proper motivation for one of skill in the art to look to Paton for meaningful teachings. More specifically, Appellants respectfully submit it is inappropriate to rely upon another teaching (Paton) for teachings when the reference being modified (Thieret) already provides teachings for which the other reference is provided.

In sum, there have been no deficiencies of Thieret identified by the Office to motivate one to look to another reference for meaningful corrective teachings. There is no evidence of record that the primary reference being modified suffers from any deficiencies or that any deficiencies would be solved by the combination proposed by the Office. There is no evidence of record that any improved operations would result from the combination proposed by the Office especially in view of the disparity of the subject matter of the reference teachings of the printing system monitoring arrangement of Thieret and the cash dispenser teachings of Paton as well as the prediction capabilities of Thieret providing just in time delivery before part failure. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Appellants' own teachings. The Office has failed to establish proper motivation for at least the above-mentioned compelling reasons and Appellants respectfully request reversal of the 103 rejection of the claims.

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Referring to pages 6-7 of the Action in the "Response to Arguments" section, Appellants respectfully assert that there is no motivation to combine the reference teachings for the above mentioned compelling reasons. The mere fact that Thieret may (or may not) be concerned with the same subject matter as Paton as alleged by the Office is insufficient to establish motivation to combine the reference teachings. Furthermore, the allegation of the Office on page 7 of the Action that "it is possible to use the data as taught by Thieret and to modify the system to use it as taught by Paton as well" is insufficient for a *prima facie* 103 rejection. The mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01III (8th ed., rev. 3) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The motivation of the present case submitted by the Office fails to meet the authority that the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification. *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993). The Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's inventions without also providing evidence of the motivational force which would impel one skilled in the art to do what the patent applicant has done. *Ex Parte Levengood* 28 USPQ2d 1300, 1302. (Bd. Pat. App. & Inter. 1993). MPEP 2144 (8th ed., rev. 3)

Appellants respectfully submit the Office has failed to meet their burden of establishing proper motivation for combining the reference teachings and accordingly the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason. Appellants respectfully request allowance of the claims.

C. There is insufficient motivation to combine the teachings of Paton with the teachings of LoBlondo and the 103 rejection of claims 62-65, 68 and 72 is improper for at least this reason.

Appellants respectfully submit that the Office has failed to establish proper motivation for a *prima facie* 103 rejection of the claims over LoBlondo and Paton and the 103 rejection is improper for at least this reason.

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The Office at page 4 of the Action states that proper motivation exists "to provide a warning when additional consumables may be required sooner than expected." Appellants respectfully submit that the bald, cursory statement by the Office is not supported by objective evidence of record and is insufficient to establish a proper *prima facie* 103 rejection.

Initially, Appellants note that the Office has cited no objective evidence of record in support of the motivational rationale provided on page 4 of the Action. Appellants respectfully submit that there is insufficient evidence of record of improvements to imaging situations resulting from combining the cash dispenser teachings of Paton compared with the teachings of the references individually to motivate one to combine the references in the first place. There is no evidence of record to support the allegation of the Office that a warning of additional consumables would in fact be provided even if the teachings of the references are combined.

As set forth in col. 1, lines 22+, LoBiondo is concerned with overcoming problems of no capabilities for tracking overall inventory of consumable supplies maintained exterior to the machine and to track usage of consumable supplies from a plurality of machines. As set forth by the summary, the reference is directed towards monitoring an inventory of consumable supplies consumed by a plurality of machines. LoBiondo provides at col. 2, lines 54+ a means for monitoring usage and there is no evidence of record that improvements to LoBiondo would be obtained over the already disclosed teachings of LoBiondo by the combination of the cash dispenser teachings of Paton to motivate one of skill in the art to combine the reference teachings. LoBiondo clearly discloses expanded consumable monitoring by monitoring status of remote machines. Furthermore, at col. 5, lines 18+ of LoBiondo, it is stated that *automation or semi-automation may be used for just-in-time inventory control*. There is no evidence of record that the combination of teachings of Paton provide any benefits over the just-in-time inventory control of LoBiondo with respect to a plurality of different consumables and Appellants respectfully submit there is insufficient objective evidence to support the combination of reference teachings.

Appellants respectfully submit that the motivational rationale presented by the Office is *redundant* to the teachings of LoBiondo and accordingly is insufficient

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to motivate one to combine the reference teachings. LoBiondo provides expanded monitoring of additional consumables and a message may be generated to an operator to show that reorder is necessary as disclosed at col. 4, lines 17+ of LoBiondo and to provide just-in-time inventory control at col. 5, lines 16+. Accordingly, LoBiondo already discloses warning when additional consumables may be required sooner than expected by the just in time control. Appellants respectfully submit it is inappropriate to rely upon a teaching of another reference when the reference being modified already provides teachings for which the other reference is provided and the Office has failed to establish sufficient motivation to combine the reference teachings for at least this reason.

Furthermore, Appellants respectfully submit that LoBiondo teaches away from the combination proposed by the Office. For example, at col. 4, lines 5+, LoBiondo discloses calculation of an S curve for each consumable item being tracked and which indicates an actual usage portion and a projected usage portion. LoBiondo discloses that the curve S may be periodically recalculated on the basis of new actual usage data. Accordingly, LoBiondo teaches away from generating an alert responsive to usage information deviating from usage profile data but to the contrary *merely recalculates the curve*. The teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). The modification proposed by the Office changes the principle of operation of LoBiondo of recalculating the curve and there is no objective evidence of record of any improvements resulting from the combination of reference teachings as proposed by the Office to motivate one to modify LoBiondo as suggested by the Office. Appellants respectfully submit the combination of Paton and LoBiondo is inappropriate in view of the following precedent stating that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01VI. (8th ed., rev. 3) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office has pointed to no deficiencies of LoBiondo to motivate one to look to another reference for meaningful corrective teachings. There is no evidence of

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record that LoBiondo suffers from any deficiencies or that any deficiencies would be solved by the combination proposed by the Office. There is no evidence of record that any improved operations of the prior art would result from the combination proposed by the Office. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Applicants' own teachings. Appellants respectfully submit the Office has failed to establish proper motivation for at least the above-mentioned compelling reasons.

Appellants respectfully submit the Office has failed to meet their burden of establishing proper motivation for combining the reference teachings and accordingly the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason. Appellants respectfully request allowance of the claims.

D. Positively recited limitations of claim 67 are not disclosed by the prior art references Thieret and Paton and the 103 rejection is improper for at least this reason.

Claim 67 recites the controller is configured to *identify the hard imaging comprising a predetermined type of hard imaging and to adjust the indication of wear responsive to the identification*. Applicants respectfully submit the prior art fails to disclose or suggest the limitations of claim 67 even if the references are combined and claim 67 is allowable for at least this reason.

More specifically, on pages 3-4 of the Action, it is alleged that the limitations of claim 67 are well known. The undersigned traversed the reliance upon judicial notice in the Response filed by Appellants on October 25, 2005 and seasonably challenged any reliance upon Official Notice pursuant to MPEP §2144.03 (8th ed., rev. 3) and requested that the Examiner cite a reference or affidavit in support of the rejection. In the final Office Action at page 7, the Office now takes the position that Appellants' traversal of the taking of Official Notice not only with respect to claim 67, but also claims 69-70 and 72 is improper. Appellants respectfully disagree.

Initially, Appellants note that the allegation on page 7 that the traversal was insufficient is not specific to any claims or arguments but is rather a generic statement apparently applied to all of Appellants' traversals in the October 25,

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2005 Response. The Office is apparently of the opinion that all of Appellants' traversals are inadequate. Appellants respectfully disagree.

The following three paragraphs were included in the October 25, 2005 Response of Appellants as traversing the reliance upon Official Notice in support of the rejection of claim 67.

MPEP 2144.03A (8th ed., rev. 3) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is not appropriate for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed., rev. 2), Applicant hereby requests evidence in a *non-final Action* with respect to what the Examiner apparently relies upon as being "well-known."

Thieret and Paton are void of any teaching or discussion of *identifying the hard imaging comprising a predetermined type of hard imaging and adjusting the indication of wear responsive to the identification* and claim 67 is allowable for at least this reason. Further, the alleged motivation provided by the Office for combining the references "in order to better deal with different types of imaging situations" is conclusory, based upon opinions of the examiner and not based upon objective evidence of record as required for a proper 103 rejection. Applicants respectfully submit claim 67 is allowable for the above-mentioned compelling reasons.

Appellants were clear that the traversal is based upon the failure of the Examiner to appropriately analyze the claims in the context of the various separately stated limitations. Not only are the specific limitations of claim 67 not disclosed in

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the prior art (and not "notoriously old and well known in the art" as baldly alleged by the Office), the combination of the limitations of claim 67 with the limitations of claims 66 and 62 is clearly not well known. The Office has failed to present any teachings whatsoever of the claimed *identifying the hard imaging comprising a predetermined type of hard imaging and adjusting the indication of wear responsive to the identification.*

As set forth above, MPEP 2144.03A provides that official notice is proper when the limitations are capable of being instantly and unquestionably demonstrated as being well known. The failure of the Office to present *any evidence* in support of the rejection of claim 67 is clear evidence in and of itself that not only are the specific limitations of claim 67 not well known but the combination of the limitations of claim 67 with the limitations of claim 66 and 62 is clearly not well known and the rejection of claim 67 is erroneous.

With respect to the alleged inadequacy of the traversal, and referring again to the requirements of an appropriate *prima facie* 103 rejection, the Office has the burden to identify prior art references which when combined disclose all of the claimed limitations. It is the Examiner's burden to establish evidence to support the rejection and with the reliance upon official notice and disregard of Appellants' traversal, the Office has inappropriately shifted the burden to Appellants to demonstrate the claims are not well known. Appellants submit the Office will recognize it is difficult to prove a negative on the part of Appellants by the nature of Appellants' position that the claimed limitations are not well known as recognized by the authority mandating the Office's burden to establish a *prima facie* 103 rejection. For official notice to be proper, the alleged well known facts must be capable of *instant and unquestionable demonstration* as being well known. Appellants respectfully submit that if the limitations of claim 67 are well known than it should be a straightforward exercise to find prior art in support of the rejection and the failure of the Office to present any evidence in support of the rejection is compelling evidence that the limitations are not well known.

Additionally, Appellants initial traversal was adequate, proper and effective in view of MPEP 2144.03(c). Appellants were clear in their response that the *combination of limitations* are not disclosed nor are the limitations taken individually. Appellants were clear that the limitations of the claims absent from the

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prior art are not well known in the claimed combination. MPEP 2144.03(c) provides that Appellant must specifically point out the supposed errors in the Examiner's action including stating why the noticed fact is not considered to be common knowledge or well known in the art. In Appellants' October 25, 2005 response, Appellants stated that the limitations of claim 67 are not disclosed or suggested even if the prior art references are combined. Appellants' response stated that the combination of specific limitations of identifying a predetermined type of hard imaging and adjusting the indication of wear responsive to the identification is not disclosed nor suggested by Thieret and Paton and can not be considered to be well known. Appellants' response clearly illustrated the errors in the Examiner's action. Appellants requested the submission of evidence from the Office in Appellants' response and none has been provided to date. Under MPEP 2144.03(c), Appellants' response was not a general allegation that the claims define a patentable invention but specifically identified the limitations believed to be allowable and not taught nor disclosed in any prior art references of record.

In accordance with MPEP 2144.03(c), Appellants respectfully submit that the claim limitations are not taught nor disclosed by the prior. Furthermore, Appellants submitted a timely and effective traversal in the October 25, 2005 response and the Office failed to provide documentary evidence in the next Action, and accordingly the rejection of claim 67 should not be maintained.

In sum, the Office has failed to meet their burden of establishing a *prima facie* 103 rejection of claim 67 and has failed to submit proper documentary evidence in support of the rejection of claim 67 in response to the timely and effective traversal of the taking of official notice. The Examiner is the entity most familiar with the prior art in the applicable art area and is in the best position to identify at least one piece of evidence in support of the rejection. The exercise of providing evidence which instantly and unquestionably supports the rejection should be straightforward if such prior art exists, apparently it does not by the inability of the Examiner to identify any prior art. No prior art had been provided and the Office in dismissing the traversal of Appellants has effectively shifted the burden to Appellants' to establish that claim 67 is patentable without reference to prior art as opposed to the Office establishing proper *prima facie* rejections of the claims. The claim limitations are not taught nor suggested by the prior art. The failure of the

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Office to comply with the requirement of MPEP 2144.03A to provide evidence which *instantly and unquestionably* demonstrates that the limitations are well known is compelling evidence that the limitations are not well known and the rejection is improper.

Appellants respectfully request withdrawal of the rejection of claim 67 for at least the above-mentioned reasons.

E. Positively recited limitations of claims 69-70 are not disclosed by the prior art references Thieret and Paton and the 103 rejection is improper for at least this reason.

Appellants traversed the reliance by the Office upon official notice in rejecting claims 69-70 in the response filed October 25, 2005. The Office failed to submit any evidence in the final Office Action to demonstrate that the limitations are well known and now alleges that the traversal of the taking of official notice by Appellants was improper. Appellants respectfully disagree and submit that the rejection of claims 69-70 is improper.

Appellants reproduce the following two paragraphs immediately below which were filed in Appellants' response dated October 25, 2005.

As discussed with the Examiner during the interview, even if disablement of a malfunctioning system is "well known," such generic disablement is not sufficient to teach the specific limitations of claims 69-70. More specifically, the respective claims recite the controller configured to disable responsive to the usage information deviating from the usage profile data. The Office in support of the rejection on page 5 of the Action relies upon the teachings of page 4, lines 3-12 of Paton. However, such teachings merely state that a flag is raised when a hardware problem exists and the remote computer 90 provides an indication to an operator that some action is needed when the flag is raised and the operator then takes any necessary action. Accordingly, the combination of prior art and "well known" teachings provides user intervention if a problem is detected and there is no teaching or suggestion of a controller configured to disable responsive to the deviation as positively recited. Claims 69-70 are allowable.

Further, Applicants respectfully submit any modification proposed by the Office to arrive at claims 69-70 based upon Paton is improper in view of the explicit

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teachings of Paton of operator notification and operator intervention and the teachings of Paton would be frustrated by a modification to arrive at the claimed subject matter reciting the claimed controller configured to disable. More specifically, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 (8th ed.) *citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992).

Above, Appellants clearly and specifically pointed out the errors in the Examiner's action including reasons why the combination of limitations are not considered to be common knowledge or well-known in the art. To reiterate the previous arguments, the specific combination of limitations of claims 69-70 reciting disablement by the controller *responsive to the usage information deviating from the usage profile data* is not well known. Furthermore, even if disabling a malfunctioning device is well known, such are not the limitations of Appellants' claims 69-70. To the contrary, the claims recite specific limitations when disablement occurs and the limitations do not recite disabling responsive to malfunctioning.

Appellants respectfully submit that the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection of the claims and the claimed limitations are not well known. Appellants respectfully request reversal of the rejection of the claims for the above-mentioned reasons.

F. Positively recited limitations of claim 72 are not disclosed by the prior art references Lo Biondo and Paton and the 103 rejection is improper for at least this reason.

Claim 72 recites the controller is configured to access a monetary budget plan with respect to the usage of the expendable over the period of time, to determine monetary cost associated with the usage of the expendable over the period of time, and to generate an alert responsive to the monetary cost exceeding the monetary budget plan.

Appellants traversed the reliance by the Office upon official notice in rejecting claim 72 in the response filed October 25, 2005. The Office failed to

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submit any evidence in the final Office Action to demonstrate that the limitations are well known and now alleges that the traversal of the taking of official notice by Appellants was improper. Appellants respectfully disagree and the rejection of claim 72 is improper.

In Appellants' response of October 25, 2005, Appellants argued that the rejection was non-sensical because an interpretation of Paton necessary to support a 103 rejection of the claims requires the *monetary budget plan* be with respect to the usage of the expendable comprising money. Further, the interpretation by the Office would also require the determination of monetary cost be associated with usage of money and the generation of an alert responsive to the cost exceeding the plan. Applicants respectfully submit a budget plan with respect to usage of money and determining the monetary cost of using money is non-sensical.

Appellants clearly and specifically pointed out the supposed errors in the Examiner's action including reasons why the *combination of limitations* are not considered to be common knowledge or well-known in the art. Appellants argued and maintain the argument that the combination proposed by the Office is non-sensical and not well known.

Appellants respectfully submit that Paton, in disclosing handling of a consumable in the form of currency, fails to disclose or suggest teachings of determining monetary cost associated with usage of the expendable over a period of time. The reliance upon official notice in the rejection of claim 72 is improper and no evidence has been provided by the Office to support the rejection.

Appellants respectfully submit that the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection of the claims and the claimed limitations are not well known. Appellants respectfully request reversal of the rejection of the claims for the above-mentioned reasons.

G. There is insufficient motivation to combine the teachings of Hopper with the teachings of Thierat and Paton and the 103 rejection of claims 73, 75, 76, 83 and 86-88 is improper for at least this reason.

The Office states on page 6 of the Action that the motivation to combine the teachings of Hopper in support of the 103 rejection is in order to more accurately reflect resource expenditure. Appellants respectfully submit the motivation is

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insufficient to support a proper *prima facie* 103 rejection of the claims. In particular, the Office has recited no objective evidence of record as supporting the motivational rationale on page 6 of the Action contrary to the authority of the MPEP and *In re Lee* recited above. In support of the combination of reference teachings, the Office merely makes unsupported allegations which, in the absence of any objective evidence, are merely the subjective opinions of the Examiner which are insufficient to establish proper motivation to combine the reference teachings.

The Office has not identified any deficiencies of Thieret or Paton which would motivate one to look to another reference for meaningful corrective teachings. There is no evidence of record that Thieret or Paton being modified suffers from any deficiencies or that any deficiencies would be solved by the combination of Hopper proposed by the Office. There is no evidence of record that any improved operations of the Thieret or Paton would result from the combination proposed by the Office. There is no evidence of record that the modification proposed by the Office would "more accurately reflect resource expenditure" as baldly alleged as the rationale for combining the teachings. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Applicants' own teachings.

Appellants respectfully submit the Office has failed to establish proper motivation for at least the above-mentioned compelling reasons and Applicants request withdrawal of the 103 rejection in the next Action.

H. Positively recited limitations of claims 73, 75, 76, 83 and 86-88 are not disclosed by the prior art references Thieret, Paton, and Hopper and the 103 rejection is improper for at least this reason.

MPEP §2143 (8th ed., rev. 3) provides that the prior art references must teach or suggest all the claim limitations for a *prima facie* 103 rejection. Furthermore, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. The Office has failed to identify

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any teachings of Hopper which allegedly disclose limitations of claims 73, 75, 76, 83, 86, 87 or 88. The rejection of the claims fails to comply with the CFR and the Office has failed to establish a proper *prima facie* 103 rejection of the claims.

Appellants respectfully submit that the Office has failed to meet their burden of establishing that the limitations of the claims are taught by the combined teachings of the prior art for a proper *prima facie* 103 rejection and Appellants request reversal of the rejection of the claims for this compelling reason.

I. **Positively recited limitations of claims 78 and 85 are not disclosed by the prior art references Thieret and Paton and the 103 rejection is improper for at least this reason.**

The Office asserts that the limitations of new claim 78 and 85 are well known on page 4 of the Action. Appellants respectfully traverse any reliance upon official notice per MPEP 2144.03A. Appellants respectfully submit that it has not been demonstrated that disablement of a malfunctioning system in and of itself is well known. Appellants respectfully additionally assert that the combination of additional limitations including automatically disabling at least a portion of a system without user input and responsive to usage information deviating from usage profile data is not well known. For example, even if it is known that supervisory personnel would turn off a malfunctioning system, it is not well known for a controller to automatically perform disablement without user input and responsive to usage information deviating from usage profile data. Also, the claims do not recite the automatic disablement without user input responsive to a malfunctioning system but instead claim the automatic disablement responsive to the claimed deviation without mention of malfunction. Even if disablement of a malfunctioning system is well known, it has not been demonstrated that such renders the claim limitations reciting disablement responsive to the deviation as well known or that the automatic disablement without user input responsive to the claimed deviation is well known.

Appellants respectfully submit the reliance upon official notice is improper and Appellants submit that the Office has failed to establish a proper *prima facie* rejection of the claims.

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J. Conclusion

In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date: 9/25/06

Attorney:



James D. Shaurette
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VIII. APPENDIX A – THE CLAIMS INVOLVED IN THIS APPEAL**Claims 1-61 [canceled].**

1 62. [Previously Presented] A system monitoring apparatus comprising:
2 a controller configured to access usage information indicative of usage of
3 an expendable which is used over a period of time by a system to perform hard
4 imaging wherein a plurality of hard images are formed upon media, to access
5 usage profile data indicative of expected usage of the expendable over the
6 period of time, to compare the usage information with the usage profile data,
7 and to generate an alert responsive to the usage information deviating from the
8 usage profile data.

1 63. [Previously Presented] The apparatus of claim 62 wherein the
2 expendable comprises a consumable comprising the media.

1 64. [Previously Presented] The apparatus of claim 63 wherein the
2 media comprises a plurality of sheets of paper.

1 65. [Previously Presented] The apparatus of claim 62 wherein the
2 usage information indicates usage of the expendable comprising one or more
3 consumable items over the period of time.

1 66. [Previously Presented] The apparatus of claim 62 wherein the
2 usage information indicates wear of the expendable comprising a component
3 having a fixed useful life.

1 67. [Previously Presented] The apparatus of claim 66 wherein the
2 controller is further configured to identify the hard imaging comprising a
3 predetermined type of hard imaging and to adjust the indication of wear
4 responsive to the identification.

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1 68. [Previously Presented] The apparatus of claim 62 wherein the
2 usage profile data comprises data derived from prior usage of the expendable by
3 the system.

1 69. [Previously Presented] The apparatus of claim 62 wherein the
2 controller is configured to disable at least a portion of the system responsive to
3 the usage information deviating from the usage profile data.

1 70. [Previously Presented] The apparatus of claim 62 wherein the
2 controller is configured to disable an entirety of the system responsive to the
3 usage information deviating from the usage profile data.

1 71. [Previously Presented] The apparatus of claim 62 wherein the
2 controller is configured to automatically generate a purchase order without user
3 interaction responsive to the usage information deviating from the usage profile
4 data.

1 72. [Previously Presented] The apparatus of claim 62 wherein the
2 controller is configured to access a monetary budget plan with respect to the
3 usage of the expendable over the period of time, to determine monetary cost
4 associated with the usage of the expendable over the period of time, and to
5 generate an alert responsive to the monetary cost exceeding the monetary
6 budget plan.

1 73. [Previously Presented] The apparatus of claim 62 wherein the
2 controller is further configured to identify a type of the hard imaging performed
3 by the system and to adjust the usage information responsive to the
4 identification.

1 74. [Previously Presented] The apparatus of claim 73 wherein the
2 controller is further configured to identify the type of hard imaging comprising
3 hard imaging of a job comprising a plurality of successive prints of the same
4 page.

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1 75. [Previously Presented] The apparatus of claim 73 wherein the
2 controller is further configured to identify the type of hard imaging comprising a
3 predetermined type of hard imaging and the adjusting comprises adjusting to
4 indicate one of increased and decreased usage.

1 76. [Previously Presented] The apparatus of claim 73 wherein the
2 expendable comprises a component, and wherein the controller is configured to
3 identify the type of hard imaging and to adjust the usage information comprising
4 wear of the component responsive to the identification.

1 77. [Previously Presented] The apparatus of claim 69 wherein the
2 controller is configured to disable at least the portion of the system to prevent
3 operations wherein the expendable is used.

1 78. [Previously Presented] The apparatus of claim 69 wherein the
2 controller is configured to automatically disable at least the portion of the
3 system responsive to the usage information deviating from the usage profile
4 data and without user input.

1 79. [Previously Presented] A system monitoring method comprising:
2 accessing usage information indicative of usage of an expendable which
3 is used over a period of time by a system to perform hard imaging wherein a
4 plurality of hard images are formed upon media;
5 accessing usage profile data indicative of expected usage of the
6 expendable over the period of time;
7 comparing the usage information with the usage profile data; and
8 generating an alert responsive to the usage information deviating from the
9 usage profile data.

1 80. [Previously Presented] The method of claim 79 wherein the
2 expendable comprises a consumable comprising the media.

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1 81. [Previously Presented] The method of claim 80 wherein the media
2 comprises a plurality of sheets of paper.

1 82. [Previously Presented] The method of claim 79 wherein the usage
2 information indicates wear of the expendable comprising a component having a
3 fixed useful life

1 83. [Previously Presented] The method of claim 82 further comprising
2 identifying the hard imaging comprising a predetermined type of hard imaging
3 and adjusting the indication of wear responsive to the identifying.

1 84. [Previously Presented] The method of claim 79 further comprising
2 disabling at least a portion of the system responsive to the usage information
3 deviating from the usage profile data.

1 85. [Previously Presented] The method of claim 84 wherein the
2 disabling comprises automatically disabling using a controller without user input.

1 86. [Previously Presented] The method of claim 79 further comprising
2 identifying a type of the hard imaging performed by the system and adjusting
3 the usage information responsive to the identifying.

1 87. [Previously Presented] The method of claim 86 wherein the
2 identifying the type of hard imaging comprises identifying a predetermined type
3 of hard imaging.

1 88. [Previously Presented] The method of claim 86 wherein the
2 expendable comprises a component, and wherein the adjusting comprises
3 adjusting the usage information comprising wear of the component.

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IX. EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

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X. **RELATED PROCEEDINGS APPENDIX**

Appellants are not aware of any related proceedings.

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